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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,720	04/09/2004	Felipe Claro	FC-03-01C01	1508
30349	7590	03/31/2006	EXAMINER	
JACKSON & CO., LLP 6114 LA SALLE AVENUE SUITE 507 OAKLAND, CA 94611-2802			MORAN, KATHERINE M	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/821,720	Applicant(s) CLARO, FELIPE	
	Examiner Katherine Moran	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 97-102 and 112-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 97-102 and 112-122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's response of 1/23/06 has been received. Applicant elected Species III with traverse and cancelled claims 63-96 and 103-111, thereby electing claims 97-102 and 112-122. Applicant did not provide a reason for the traversal other than asserting that cancelled claims 70-73, 76, 78, 81-86, 88-92, and 96 are also directed to the subject matter of Species III. Applicant's response noted that claims 93-96 are pending. However, since claims 93-96 are included in the listing of claims as being cancelled, claims 93-96 are considered to be cancelled. Applicant did not include a listing of all claims readable upon the elected species as required by the election requirement. However, in the interest of compact prosecution, it is presumed that Applicant intended for the pending claims 97-102 and 112-122 to be readable upon Species III.

Specification

2. The disclosure is objected to because of the following informalities: pg.1, line 6: insert --, now US Patent No. 6,718,557-- after "2002".

The use of the trademark Velcro has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Objections

3. Claims 97, 113, and 115 are objected to because of the following informalities:
claim 97: delete "Velcro" and insert --hook and loop--, line 4: delete "rear" and insert --back-- in order to maintain consistency with the earlier part of the claim, line 7: insert --or back-- after "front"; claim 113: delete "Velcro" and insert --hook and loop--; claim 115: line 1: insert --one-- after "wherein the". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 97-102 and 112-122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 97 recites "its underside". It is not clear what structural feature "its" is referring to. Claims 97 and 112 recite "the junction". Regarding claim 97, the structural elements recited by "and/or textile" and "textile and/or Velcro" is not clear. The specification does not recite the textile embodiment with an "and/or" phrase. Claim 99 recites "the visor zone". Claim 115 recites the limitation "the underside". There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 112, 115, and 118-120 are rejected under 35 U.S.C. 102(b) as being anticipated by Solomon (U.S. 1,419,771). Solomon discloses the invention as claimed. Solomon teaches an adjustable hat comprising a crown 5 having an adjustable circumferential portion at its bottom and having front and back portions and two side portions. The hat includes a visor 8, having side edges, attached to the front portion of the crown, a pair of flaps 7 each formed at the junction of the front and side portions near the side edges of the visor, a pair of adjustment clasps 13,14 to alter the size of the circumferential portion of the crown, wherein each of the pair of clasps is located with one part 14 of the clasp is located within the flap and the mating clasp is on the crown, wherein the pair of flaps hides or partially hides the pair of adjustment clasps. Each of the clasps 14 is mounted on the underside of the flap and the flaps are of any desired shape. The geometry of the flap comprises a logo in that the flap is tapered, with the tapered geometry representing a particular logo shape.

8. Claims 97-102 are rejected under 35 U.S.C. 102(b) as being anticipated by Frank (U.S. 4,864,662). Frank discloses the invention as claimed. Frank teaches an adjustable hat comprising a crown 10 having an adjustable circumferential portion at its bottom and having front and back portions and two side portions 13a,13b, a visor 11a or

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11b attached to the front or rear portion of the crown, a pair of hook and loop adjustment clasps 30,31 or 28a,b and 29a,b to alter the size of the circumferential crown portions, a plurality of panels forming the crown (col.5, lines 60-64), flaps 17 or 15 and including the portions of the crown on either side of slit 12) formed at the junction of the front and side portions near the visor to hide or partly hide the clasps. Each of the pair of clasps comprises a strap or patch (28a, 28b, or 30) attached at one end of the flap and having on its underside one part of a hook and loop patch and a mating patch of hook and loop 29a,29b positioned on the exterior of the crown above the visor, or within the visor zone. Depending upon which part of the crown is called the front, either one of 29a or b would be located on the side portion between the ears and eyes of the wearer. The flaps have an inherent geometric shape which could represent a logo.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 113 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '771. Solomon discloses the invention substantially as claimed.

However, Solomon doesn't teach that the adjustable clasps are Velcro or magnets.

Applicant's specification does not provide criticality or unexpected results for employing

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one type of fastener over another. It is well known in the art that various types of fastening mechanisms are functionally equivalent. Hook and loop, button and buttonhole, hook and catch, snaps and adhesive are a few examples. These fasteners may be used interchangeably depending upon the desired aesthetic effect. Therefore, it would have been obvious to one of ordinary skill in the art to substitute the magnet or Velcro clasps in place of Solomon's, because each are readily available and user-friendly.

11. Claims 121 and 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '771 in view of Loeffelholz (U.S. 6,175,963). Solomon discloses the invention substantially as claimed. However, Solomon doesn't teach a logo affixed to the outside of the flap. Loeffelholz teaches headgear 12 with a logo 32 positioned on the exterior crown surface. It is known to provide headgear w/logos on various parts of the crown in order to achieve a desired aesthetic effect. Therefore, it would have been obvious to one of ordinary skill in the art to provide Solomon's flap with a logo such that the logo is visible to those looking from a sideways perspective.

Allowable Subject Matter

12. Claims 116 and 117 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claim 97 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 5 of U.S. Patent No. 6,718,557.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application include the hook and loop attachment means recited in claims 4 and 5.

15. Claims 112, 116, and 117 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,718,557. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because each structural element recited in the claims of the present invention is also included in the '557 patent.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine Moran whose telephone number is 571-272-4990. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 571-272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katherine Moran
Primary Examiner
Art Unit 3765

Kmm
March 27, 2006